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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,647	02/27/2002	Jan Sunner	056622-5001	1807
9629	7590	03/11/2004	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				KALIVODA, CHRISTOPHER M
ART UNIT		PAPER NUMBER		
		2881		

DATE MAILED: 03/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/083,647	SUNNER ET AL.
	Examiner	Art Unit
	Christopher M. Kalivoda	2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on December 19, 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1,3-5,7-24,26-31 and 34-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 1,3-5,7-24,26-31 and 34-64 is/are allowed.
- 6) Claim(s) 65 and 66 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments, with respect to the claims have been fully considered and are persuasive. The rejection of the claims has been withdrawn.

### ***Claim Objections***

2. Claim 65 is objected to because of the following informalities: There appears to be an extra word "rate" after the word "substrate" in line 2. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65 and 66 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. Claim 65 describes a device for generating ions comprising a non-porous substrate with a roughness. However, there is no embodiment to the claim to describe a method or apparatus using the porous substrate with certain roughness.

***Allowable Subject Matter***

4. Claims 1, 3-5, 7-24, 26-31 and 34-64 are allowed.
  
5. The following is a statement of reasons for the indication of allowable subject matter. The Applicant filed an amendment received on December 19, 2003. In this amendment, Applicant amended claims 1, 5, 7, 20, 26, 27, 38 and 41, cancelled claims 2, 6, 25, 32 and 33 and added new claims 56-66. No new matter was introduced.

Regarding independent claims 1 and 56, a review of prior art failed to disclose or make obvious a method of producing an analyte ion comprising exposing a non-porous rough surface to a laser to produce an ionized gas phase analyte wherein the contacting of the analyte with the non-porous rough surface occurs *in situ* before and after exposing the non-porous surface to a laser.

Regarding independent claims 27 and 41, a review of prior art failed to disclose or make obvious a device or method for generating analyte ions comprising a non-porous rough surface with a surface roughness between about 2 nm and about 100 nm.

Regarding independent claim 61, a review of prior art failed to disclose or make obvious a device for generating analyte ions comprising a substrate having a non-porous rough surface having a surface area difference that varies from approximately 20% to approximate 40%.

Dependent claims 3-5, 7-24, 26, 28-31, 34-40, 42-55, 57-60 and 62-63 are allowable by virtue of their dependence upon claims 1, 27, 41, 56 and 61 respectively.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,854,486 to Dreyfus describes a device for generation of ions using a laser on a non-porous surface.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Kalivoda whose telephone number is (571) 272-2476. The examiner can normally be reached on Monday - Friday (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Lee can be reached on (571) 272-2477. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Chris Kalivoda*  
Chris Kalivoda  
AU 2881  
27 February 2004

*Nikita Wells* 03/02/04  
NIKITA WELLS  
PRIMARY EXAMINER